



05/30/97

PATENT

Docket No. 2026-4205

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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CERTIFICATE OF MAILING (37 C.F.R. 1.8a)

**ASSISTANT COMMISSIONER FOR PATENTS
Washington, D.C. 20231**

Sir:

I hereby certify that the attached 1) Response to Restriction Requirement; 2) Petition and Fee for Extension of Time (37 C.F.R. §1.136(a)) and check in the amount of \$110.00; and 3) Return postcard (along with any paper(s) referred to as being attached or enclosed) and this Certificate of Mailing are being deposited with the United States Postal Service on the date shown below with sufficient postage as first-class mail in an envelope addressed to the: Assistant Commissioner for Patents, Washington, D.C. 20231.

Respectfully submitted,

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69652 U. S. PTO
05/30/97

PATENT

Docket No. 2026-4205

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of : Topalian, et al.
Serial No. : 08/533,895 Art unit : 1817
Filed : September 26, 1995 Examiner : Caputa, A.
For : MHC CLASS II RESTRICTED MELANOMA ANTIGENS
AND THEIR USE IN THERAPEUTIC METHODS

RESPONSE TO RESTRICTION REQUIREMENT

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

In response to the PTO Official Action mailed on April 11, 1997, please amend the above-identified application.

REMARKS

The Examiner has required restriction under 35 USC §121 as follows:

I. Claims 31-46, 62 and 63, drawn to a nucleic acid, classified in class 536, subclass 23.5;

II. Claims 1-30, 56 and 61 drawn to a peptide, tumor associated antigens or melanoma antigens, classified in class 530, subclass 326+;

III. Claims 47-51, drawn to an antibody, classified in class 530, subclass 387.9;

IV. Claims 57-60, drawn to a method of isolating class II tumor associated antigens, classified in class 530, subclass 412.

With all due respect, applicants disagree that the Examiner's requirement is proper. However, in order to facilitate prosecution and to avoid a holding of non-responsiveness, applicants elect the claims of Group II (claims 1-30, 56 and 61) with traverse. Applicants further elect, with traverse, species A (Ty 56-70; Ty 57-70; Ty 56-70, L65→V; Ty 56-70, A63→V and L65→V; Ty 56-70, A63→V; and X₁LLX₂NX₃X₄LX₅) for examination on the merits. In the event that the Examiner does not withdraw the requirement, applicants expressly reserve the right to file a divisional application to the presently non-elected subject matter.

The Examiner has distinguished the Groups on the basis that the subject matter has different structure and biological properties. However, only two classes of art have been identified to be searched for the four restricted Groups. Applicants point out that MPEP 805 at page 800-4 states that restriction is not proper even where there are separate and distinct inventions if the search burden on the Examiner to examine all of the pending claims is not great. Such is clearly the case herein since a complete search of all the claims as set forth by the Examiner would involve a search of only one additional Class of art. In weighing the burden of the Examiner against the possible detrimental effect on applicants, it is believed

that the equity lies on the side of applicants. Reconsideration and withdrawal of the Group restriction is respectfully requested.

In addition, applicants strongly disagree with the Examiner's requirement that separate species be selected. These species are all tumor-associated antigens and therefore fall into one specific category of proteins/peptides and should be examined together. In particular, applicants strongly disagree with the Examiner's separation of two peptide regions within the SAME protein (species A and B). These peptides are derived from ONE protein, Tyrosinase, and should be examined together. Reconsideration and withdrawal of the species restriction is respectfully requested.

For the foregoing reasons, applicants request reconsideration of the Examiner's requirement. An examination of all of the claims and the issuance of an Official Action on the merits of all the pending claims is requested.

It is believed that the elected claims are in condition for allowance. Early and favorable action by the Examiner is earnestly solicited.

If the Examiner believes that issues may be resolved by a telephone interview, the Examiner is respectfully urged to telephone the undersigned at (212) 415-8564. The undersigned may also be contacted by e-mail at drauth@morganfinnegan.com.

AUTHORIZATION

No additional fee is believed to be necessary.

The Commissioner is hereby authorized to charge any additional fees which may be required for this amendment, or credit any overpayment to Deposit Account No. 13-4500, Order No. 2026-4205.

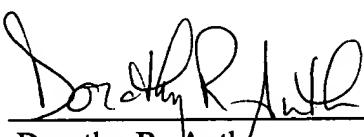
In the event that an extension of time is required, or which may be required in addition to that requested in a petition for an extension of time, the Commissioner is requested to grant a petition for that extension of time which is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to Deposit Account No. 13-4500, Order No. 2026-4205. A DUPLICATE OF THIS SHEET IS ATTACHED.

Respectfully submitted,

MORGAN & FINNEGAN

Dated: May 27, 1997

By:



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